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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,213	02/28/2002	Shinichi Sato	11301-1481	8571

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/085,213

Applicant(s)

SATO ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 46-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/242,525.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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1. Claims 48 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Despite applicants' response and amendment, the process as it pertains to compound (i) remains indefinite. Specifically, the language within lines 4 and 5 of claim 48 is unclear with respect to what is being reacted. The language, "reacting a compound obtained by reacting a compound (eb) with a compound (fb) and further reacting with a compound (i)", is confusing, because it cannot be determined what is being initially reacted with the "obtained" compound, since compound (i) is claimed as being "further" reacted. In other words, there appears to be too many occurrences of "reacting".

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barron et al. ('844) or Zwiener et al. ('955).

Barron et al. disclose the production of curable urethane compositions wherein an isocyanate terminated prepolymer, derived from the reaction of a polyol with a polyisocyanate, is reacted with the reaction product of an aminoalkylalkoxysilane and a carbonyl or nitrile containing compound. See column 1, lines 50+; column 2, lines 59+; and column 3, lines 37-56.

Zwiener et al. disclose the production of alkoxysilane-functional polyurethane prepolymer, wherein an isocyanate terminated prepolymer, derived from the reaction of a polyol and a polyisocyanate, is reacted with the reaction product of an aminoalkylalkoxysilane and a maleic or fumaric acid ester. See column 2, lines 24+ and examples 6-9.

4. Applicants' process differs from the prior art processes in that applicants react the isocyanate with the amine functional alkoxysilane adduct to yield an isocyanate functional intermediate which is then reacted with the polyol, as opposed to reacting the isocyanate functional prepolymer with the adduct. The position is taken that the respective processes yield the same product and the only difference amounts to how the polyol is incorporated into the final product. This situation is considered to be analogous to changing the sequence of steps in a multi-step process, and it has been held that such a modification is obvious where an unexpected result is not obtained. *Ex parte Rubin* (POBA 1959) 128 USPQ 440; *Cohn v. Comr. Pats.* (DCDC 1966) 251 F Supp 378, 148 USPQ 486. Therefore, the position is ultimately taken that it would have been *prima facie* obvious to modify the reaction sequence of the prior art so as to arrive at the instant process.

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5. Applicants' response has been considered; however, the response is insufficient to remove the prior art rejection for the following reasons. Firstly, applicants' arguments within pages 8 and 10 concerning side reactions occurring within the references amounts to unsubstantiated opinion. Applicants have not provided evidence or logical rationale to support their position. Similarly, applicants have not substantiated their arguments with respect to molecular weight or viscosity, and it is noted that applicants' claims are not limited in accordance with these arguments. Secondly, applicants' arguments are largely based upon the position that the instant products have an OH group in the terminal; however, applicants' claims are not so limited. There is no requirement that such a terminal OH group exists or be produced. In summation, applicants' arguments are not commensurate in scope with the claims and applicants have in no way established that the respective processes yield distinct products.

6. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krafcik ('604).

Patentee discloses the reaction of an isocyanate functional material, a polyol, and an aminoalkyl silane, wherein the reaction is conducted by reacting the isocyanate functional material with the polyol to yield a product, which is then reacted with the aminoalkyl silane. See abstract; column 2, lines 30+; column 4, lines 37+; and column 5, lines 31+. Patentee further teaches at column 5, lines 24-30 that other processes may be employed to produce the composition of the reference.

7. While the prior art sequence of reaction differs from applicants, the position is taken that the same products are being produced. Therefore, since patentee teaches that different processes may be employed to produce the product, and since it has been held that changing the sequence of steps in a process is obvious where an unexpected result is not obtained (*Ex parte Rubin*

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(POBA 1959) 128 USPQ 440; *Cohn v. Comr. Pats.* (DCDC 1966) 251 F Supp 378, 148 USPQ 486), the position is taken that it would have been obvious to modify the disclosed reaction sequence, so as to arrive at the instant process.

8. Applicants' response has been considered; however, the response is insufficient to remove the prior art rejection for the following reasons. Firstly, applicants' argument that Krafcik is drawn to a dispersion whereas the instant claim is drawn to a moisture curable product does not distinguish the claim from the prior art. Nothing in applicants' claim requires the product to be moisture curable and nothing in applicants' claim excludes the argued dispersions. The claim is open to virtually any step or modification. Secondly, applicants' argument concerning viscosity is not commensurate in scope with the claim; nothing requires the product of claim 50 to have low viscosity. Lastly, applicants have stressed that the product of claim 50 has a terminal OH group; however, applicants' claim is not so limited. There is no requirement that such a terminal OH group exists or be produced. In summation, applicants' arguments are not commensurate in scope with the claims and applicants have in no way established that the respective processes yield distinct products.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sergent  
October 30, 2005